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Christophe Berthaud

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GRIFFIN & SZIPL, PC

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2300 NINTH STREET, SOUTH

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHE BERTHAUD

Appeal 2009-015438
Application 09/631,413
Technology Center 2600

Before ROBERT E. NAPPI, KENNETH W. HAIRSTON, and
MAHSHID D. SAADAT, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

This is a decision on appeal under 35 U.S.C. § 134(a) of the rejection of claims 1 through 5, 7, 8, and 10 through 18.

We reverse and enter a new rejection.

INVENTION

The invention is directed to a watch with a control device for a computer cursor. Specification 1.

Claim 1 is reproduced below:

1. A watch including display means for at least one item of time related data and having an at least partially transparent outer element covering said display means or forming an outer portion of the display means, said watch including first control means for controlling the movement of a cursor on a computer screen, said first control means being formed of a plurality of touch sensitive sensors with each touch sensitive sensor having a touch sensitive pad being at least partially transparent and the touch sensitive pads are supported at least partially by said outer element such that the display means are at least partially visible through the touch sensitive pads and the outer element, wherein the touch sensitive sensors are of the capacitive type and sensitive pads are formed by electrodes deposited underneath the outer element, and wherein it further includes means for detecting the speed of a user's finger over said outer element or the actuation frequency of successive sensors.

REFERENCES

Olsen	US 6,137,479	Oct. 24, 2000
Terés	US 6,184,871 B1	Feb. 6, 2001
Ferrari	US 6,392,636 B1	May 21, 2002

REJECTIONS AT ISSUE

The Examiner has rejected claims 1 through 5, 7, 8, and 10 through 18 under 35 U.S.C. § 103(a) as being unpatentable over Terés in view of Olsen and Ferrari. Answer 3-13.²

ISSUES

Appellant argues on pages 8 through 21 of the Appeal Brief³ that the Examiner's rejection of independent claims 1, 10, and 13 under 35 U.S.C. § 103(a) is in error. Appellant argues that none of the three references applied by the Examiner in rejecting the claims teaches:

(i) the "means for detecting the speed of a user's finger over said outer element or the actuation frequency of successive sensors" as recited in claim 1 ; (ii) "the direction of movement of said cursor depends on the concentric zones actuated or two adjacent concentric zones which are actuated simultaneously" as recited in claim 11; and (iii) the "second control means for selecting an object shown on said screen or carrying out a command relating to said object, and wherein said second control means are also formed by a touch sensitive sensor performed by means of a capacitive sensor supported by the outer element and located in the central region thereof" as recited in claim 13.

Brief 10-11, 14, and 15.

Thus, Appellant's arguments with respect to claim 1 present us with the issue: Did the Examiner err in finding that the combination of Terés,

² Throughout this decision we refer to the Answer dated April 29, 2009.

³ Throughout this decision we refer to the Appeal Brief dated May 25, 2006, and the Reply Brief dated August 21, 2006, and the Supplemental Reply Brief Dated June 29, 2009.

Olsen, and Ferrari teaches a means for detecting the speed of a user's finger as recited in claim 1?

Appellant's arguments with respect to claim 10 present us with the issue: Did the Examiner err in finding that the combination of Terés, Olsen, and Ferrari teaches that the direction of movement of said cursor depends on the concentric zones actuated or two adjacent concentric zones which are actuated simultaneously as recited in claim 10?

Appellant's arguments with respect to claim 13 present us with the issue: Did the Examiner err in finding that the combination of Terés, Olsen, and Ferrari teaches a second control means for selecting an object shown on said screen or carrying out a command relating to said object as recited in claim 13?

ANALYSIS

Independent claim 1

Appellant's arguments have persuaded us that the Examiner erred in finding that the combination of Terés, Olsen, and Ferrari teaches a means for detecting the speed of a user's finger. Claim 1 recites a watch with a display and a control means for controlling a cursor on a computer screen which includes "means for detecting the speed of a user's finger over said outer element or the actuation frequency of the successive sensors." As discussed *infra*, we now reject claim 1 as indefinite under 35 U.S.C. § 112, second paragraph as no structure is disclosed to perform the claimed function. Nonetheless, claim 1 includes a recitation that an indefinite item performs the function of detecting the speed of a user's finger or actuation frequency of successive sensors.

In response to Appellant's arguments that this function is not taught in the combined references the Examiner states:

Ferrari discloses in Fig.5A-5G, 6-7, and column 11 the actuation frequency of sensors as the user's finger or fingertip actuates/deactuates on a plurality of sensors wherein the X and Y outputs depend upon the displacement and pressure of the user's finger or fingertip on the touch-sensitive pads. The actuation frequency of sensors depends upon the user's rate of lifting/pushing sensors by a fingertip or moving the finger away/towards the sensors. Therefore, the cursor movement on a computer screen is controlled by the actuation frequency by the user's rate/speed/frequency of lifting/pushing fingertip, i.e., the user's speed of movement of a fingertip.

Answer 12.

We have reviewed the cited sections of Ferrari and while column 11 lines 32-40 does discuss sensing two sets of x-y coordinates of the finger tip, we do not find a discussion, in column 11 or Figures 5A-5G, 6, and 7, of measuring speed or frequency (nor do we find that the time between the two sets of coordinates is monitored to determine some form of rate of change of position). Thus, we do not find that the combination of Terés, Olsen, and Ferrari teaches the function of detecting the speed of a user's finger or actuation frequency of successive sensors. Thus, as the scope of the claim is indefinite (as to what device performs the function of detecting speed or frequency), and the art cited by the Examiner does not teach performing the claimed function, we will not sustain the Examiner's rejection of independent claim 1 and dependent claims 2 through 5, 7, 8, 11, 12, and 14 through 18.

Independent claim 10

Appellant's arguments have persuaded us that the Examiner erred in finding that the combination of Terés, Olsen, and Ferrari teaches that the direction of movement of said cursor depends on the concentric zones actuated or two adjacent concentric zones which are actuated simultaneously. Claim 10 recites "wherein said sensitive pads are arranged in concentric zones, the direction of movement of said cursor being determined by the orientation of the pad or pads actuated relative to the centre of said concentric zones, and wherein the speed of movement of said cursor depends on the concentric zone actuated or two adjacent concentric zones which are actuated simultaneously." Thus, the scope of claim 10 includes that there are concentric zones and that the speed of the cursor depends upon which zone is actuated.

The Examiner finds that Terés teaches a wristwatch having concentric zones as shown in Figure 3. Answer 9, 18. We concur with this finding. With regard to the speed of movement, the Examiner cites to Figures 4 and 5 and finds that Olsen discloses cursor movement. Answer 9. While we concur with the Examiner's finding that Olsen discloses controlling the movement of the cursor (see e.g. col. 2. ll. 8-14), the Examiner has not identified where Olsen teaches that the speed of the cursor depends upon which zone is actuated. Further, the Examiner in responding to Appellant's arguments states "Ferrari discloses the direction of movement of said cursor depends on the concentric zones actuated or two adjacent concentric zones which are actuated simultaneously because fingertip or finger's movement may cover two adjacent sensors among a plurality of sensors arranged in concentric zones which are actuated simultaneously." Answer 12. As with

Olsen, we find that Ferrari discloses controlling the movement of the cursor (see e.g. col. 4, ll. 33-41), but the Examiner has not identified where Ferrari teaches that the speed of the cursor depends upon which zone is actuated. Thus, the Examiner has not shown, nor do we find, any teaching in Terés, Olsen, and Ferrari that the direction of movement of said cursor depends on the concentric zones actuated or two adjacent concentric zones which are actuated simultaneously. Accordingly, we will not sustain the Examiner's rejection of independent claim 10.

Independent claim 13

Appellant's arguments have persuaded us that the Examiner erred in finding that the combination of Terés, Olsen, and Ferrari teaches a second control means for selecting an object shown on said screen or carrying out a command relating to said object. Claim 13 recites a second control means for selecting an object shown on a screen or carrying out a command relating to the object where the second touch means is formed of a capacitive sensor located in a central region of an the outer element. The Examiner finds that Terés, in Figures 1-5 and columns 1-5, teaches a second control means located in a central region thereof. Answer 13. We concur with the finding that Terés teaches a touch sensor located in a central region of an outer ring of touch sensors (see section S of Figure 3, which is central to the regions A-L and M-R, and col. 2, ll. 40-43). However, the Examiner has not shown that this sensor is used to select an object on a screen or carry out a command relating to the object on the screen. We recognize that Olsen teaches separate switches to generate signals to select items displayed on a screen. Col. 3, ll. 49-50. However, the Examiner has not shown, nor do we

find, that using this teaching of Olson in conjunction with the central capacitive sensor of Terés would have been obvious. Accordingly, we will not sustain the Examiner's rejection of independent claim 13.

New Rejection of claims 1 through 5, 7, 8, 11, 12, and 14 through 18 under 35 U.S.C. § 112, second paragraph.

Claim 1 recites a “means for detecting the speed of a user's finger over said outer element or the actuation frequency of the successive sensors.” Thus, claim 1 invokes 35 U.S.C. § 112, sixth paragraph as it recites “means for.” In accordance with 37 C.F.R. 41.37(c)(1)(v), Appellant has stated that the corresponding structure for the means for detecting speed is disclosed on pages 4 and 5, Figure 1, and Figure 4 of the Specification. Brief 7. We note that Appellant's Specification on page 4 describes using tracking the movement of the user's finger over the crystal and using this to determine the frequency or speed of the user's finger over the sensor. The Specification further states that “the means for detecting the speed of the finger movement of the actuation frequency of the successive sensor may be imagined by those skilled in the art without any major difficulty.” Specification 5: 6-8. Thus, Appellant's Specification does not actually identify the specific structure which performs the function of determining speed or frequency and as such, claim 1 is indefinite under 35 U.S.C. § 112, second paragraph. “[I]f one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section

§ 112.” *In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994)(*en banc*).
see also Aristocrat Technologies, Inc. v. International Game Technology,
521 F.3d 1328, 1333 (Fed. Cir. 2008). Thus, we enter a new rejection of
independent claim 1 and dependent claims 2 through 5, 7, 8, 11, 12, and 14
through 18.

CONCLUSION

Appellants have persuaded us of error in the Examiner’s rejection of
claims 1 through 5, 7, 8, and 10 through 18.

ORDER

The decision of the Examiner to reject claims 1 through 5, 7, 8, and 10
through 18 is reversed. A new rejection is entered against claims 1 through
5, 7, 8, 11, 12, and 14 through 18.

NEW GROUNDS OF REJECTION

This decision contains new grounds of rejection pursuant to 37 C.F.R.
§ 41.50(b) (2007). This regulation states that “[a] new ground of rejection
pursuant to this paragraph shall not be considered final for judicial review.”
Furthermore, 37 C.F.R. § 41.50(b) also provides that Appellant, **WITHIN
TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise
one of the following two options with respect to the new grounds of
rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate
amendment of the claims so rejected or new evidence relating
to the claims so rejected, or both, and have the matter
reconsidered by the examiner, in which event the proceeding
will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

Appeal 2009-015438
Application 09/631,413

REVERSED

37 C.F.R. § 41.50(b)

ELD

GRIFFIN & SZIPL, PC
SUITE PH-1
2300 NINTH STREET, SOUTH
ARLINGTON, VA 22204